

## REMARKS

In the outstanding Office Action, the Examiner rejected claims 1-18. Claims 1-18 are pending and under consideration.

### Rejection Under 35 U.S.C. § 103(a):

The Examiner rejected claims 1-18 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Pat. No. 5,311,397 to Harshberger et al., ("Harshberger") in view of U.S. Pat. No. 4,856,295 to Bolton et al., ("Bolton") and further in view of U.S. Pat. No. 5,887,916 to Finkelstein et al., ("Finkelstein"). Office Action at pages 2 to 3.

However, even if the teachings of Harshberger, Bolton and Finkelstein can be modified or combined as proposed by the Examiner, the resultant combination would fail to satisfy all of the claimed limitations. The Examiner stated that "[i]t would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the screw as disclosed by Bolton instead of a locking assembly as disclosed by Harshberger." Office action at page 2. Bolton teaches that a

screw 28 is provided to secure the locking member 23 against the front wall 21 of the deck 18. The screw 28 passes through the front wall 21 by way of a slot 29 which allows the screw 28 to *horizontally reciprocate* with the lock member 23 so as to move between the lock and unlocked positions.

Col. 2, lines 57-61 (emphasis added). Accordingly, Bolton discloses a screw that is used to secure a horizontally-reciprocating lock member. The screw as disclosed by Bolton does not rotate anything other than the screw itself and serves merely to secure the lock member in place.

Claim 1 recites a panel mountable electronic device comprising, among other things, "a screw wherein said screw may be passed through said hole in said flange and engaged in said threaded hole such that *a rotation of said screw rotates said tab into position to clamp a portion of said panel between said tab and said flange*" (emphasis added). In contrast, the combination of Harshberger and Bolton, as suggested by the Examiner, would replace the locking assembly of Harshberger with the setscrew-based, horizontally-reciprocating lock member of Bolton. As stated

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

above, the screw as disclosed in Bolton acts as a setscrew to restrain further motion of the horizontally reciprocating lock member. Rotation of this screw does not "rotate said tab into position to clamp a portion of said panel," as recited by the claims of the present invention. In contrast, rotation of the screw as disclosed by Bolton merely frees the lock member to move freely in a horizontal direction, this horizontal movement engaging the tab into position. As a result, the Harshberger-Bolton-Finkelstein combination does not teach or suggest each and every element of claim 1. MPEP 2143.03. For at least this reason, Applicant respectfully submits that claim 1 is patentable over this combination.

In addition, as previously discussed, Applicant respectfully submits that the Harshberger reference cannot be properly modified or combined with the other cited references because they do not contain the requisite suggestion or motivation to combine. Rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references "*is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'*" *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), *abrogated on other grounds* (citations omitted) (emphasis added).

The combination suggested by the Examiner would render the Harshberger reference unsatisfactory for its intended purpose, thus there is no suggestion or motivation to make it. MPEP 2143.01. Harshberger teaches a "combination key operated lock and switch assembly" having at least two separate purposes. The switch portion electrically connects to the power supply unit and logic circuitry to turn the CPU module on and off (see col. 6, lines 11-16). The lock portion includes a key that allows for locking the latch in a secure position while limiting access to the component to the holder of the key (see col. 6, lines 11-38). Harshberger states a specific part number and manufacturer as an example of what would accomplish these two purposes (see col. 6, lines 36-38).

Contrary to what the Examiner suggested, the combination of the screw as disclosed by Bolton instead of the key-operated lock and switch assembly of

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Harshberger would defeat at least the two intended purposes discussed above.

Specifically, using the screw as disclosed by Bolton would not allow the user to either lock or control access to removal of the electronic component. Similarly, the use of the screw would not allow for the user to electrically connect to the power supply unit.

In addition, "[t]he mere fact that references can be modified or combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Harshberger does not suggest the desirability of the proposed combination. Indeed, Harshberger suggests a teaching away because, as discussed above, supplanting the locking assembly with the screw as disclosed by Bolton precludes certain objectives that the locking assembly provides. Further, the screw as disclosed by Bolton does not engage the tab by rotation, as suggested by Harshberger, but instead acts merely to secure the horizontal movement of the tab into position. Harshberger certainly does not suggest that it is desirable to combine the screw as disclosed by Bolton because doing so would vitiate some objectives of its invention and would change the principle of operation of the Harshberger tab from a rotating member to a horizontally reciprocating member. See MPEP 2143.01 ("If the proposed modification or combination of the [reference] would change the principle of operation of the [referenced] invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious"), citing *In re Ratti*, 270 F.2d 810 (CCPA 1959) (Court reversing USPTO rejection while holding that the suggested combination of references would require a reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle under which the primary reference construction was designed to operate).

Claims 2-10 all depend from claim 1. Thus, these claims are allowable for at least the same reasons discussed above for claim 1.

The arguments above relating to claim 1 apply equally to claim 11. Thus, for at least these reasons, Applicant respectfully submits that claim 11 is patentable over the Harshberger-Bolton-Finkelstein combination.

Claims 12-18 all depend from claim 11. Thus, these claims are allowable for at least the same reasons discussed above for claim 11.


In view of the foregoing arguments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 24, 2003

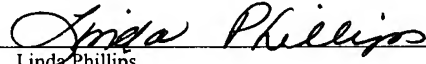
By:   
John Y. Pfeifer  
Reg. No. 52,120

CERTIFICATE OF EXPRESS MAILING

Express Mail Label No.: EV 351294205 US

I hereby certify that this correspondence is being deposited with the United States Postal Services "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below.

Date July 24, 2003

Signed:   
Linda Phillips

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com